REMARKS

Currently, claims 1-22 are pending. The Examiner in paragraph 3 of the Official Action rejected claims 1-5, 10, 11, 13, and 17-22 under 35 USC § 103(a) as being unpatentable over Shiota (US Patent No. 6,324,521) in view of US patent application US 2003/0005132A1 (Nguyen). Applicant respectfully submits that the Shiota reference either alone or in combination with Nguyen does not teach or suggest the claimed invention.

Independent claim 1 is directed to a method of selecting a digital photographic service provider from a plurality of different service providers and providing a photographic image service with respect to at least one digital image located at a user location remote of said selected photo service provider. The method includes providing a service directory on a server accessible over a communication network which includes an entry for a plurality of different unrelated service providers. The method further includes providing a criterion to the service provider with respect to a selection of a service provider. Claim 1 further includes automatically providing the user with a list of one or more plurality of unrelated different service providers based on said criterion for display on the user display device. In step (d) of claim 1, the user selects one of the plurality of different service providers on the provided list and steps (e) and (f) are directed to requesting a particular service by the user and then providing of the service to the service provider.

The present claimed invention can be distinguished from Shiota by at least the following points:

    1)   the user provides a criterion to the service provider with respect to providing a selection of a service provider;

    2)   that a list of providers is provided to the user based on the criterion provided by the user; and

    3)   that the list comprises one or more unrelated different service providers.

The Examiner suggests that in Shiota, the user provides criterion for the selection of a service provider and in particular refers to column 2, lines 29-33. This portion of the Shiota is directed to the placement of an order by placing input information into a predetermined screen. This does not teach or suggest that the user provide a criterion to the service directory for obtaining a list of different service providers. Quite the contrary, this portion is already dealing

with the placement of an order. The Examiner refers to column 3, lines 5-10 for the providing of a service directory. The passage referred to by the Examiner in column 3, lines 5-10 is directed to the selection by the service provider of where the order is to be fulfilled. This part of the specification is dealing with the service center selecting the appropriate laboratory based upon the appropriate equipment to provide the desired product that has been ordered. While Shiota discloses that the customer may select the laboratory that is to output the print, there is no teaching or suggestion that this is based on any criterion applied by the user. As set forth in column 6, lines 21-22, Shiota discusses the fact that there is provided a number of affiliated laboratories. This affiliation indicates that the selection by the user is based on an already existing affiliation. There is nothing that indicates that the output <u>list is provided in response to a criterion</u> supplied by the user as claimed by applicants. Furthermore, it can be seen that the service providers are not unrelated as also taught and claimed by applicant. Applicant further directs the Examiner to column 9, lines 16-25, that when the customer wishes to receive the print over the counter, the order information data shows the laboratory at which the print is received is referred to, and the laboratory is selected as the laboratory to output the print. As further set forth, when no laboratory is specified in the order information, the laboratory which stores the high resolution image is selected. (See column 9, lines 21-22). As previously stated, there is no teaching or suggestion of developing a list of service providers based on a criterion provided by the user.

In summary, applicant respectfully submits that the Shiota fails to teach the invention as set forth in the independent claims for the reasons set forth above.

The Examiner states that Shiota fails to disclose the use of a service directory and cites Nguyen. Applicant respectfully submits that the Nguyen reference does not teach or suggest anything in combination with Shiota that would render applicants invention obvious. In this regard, applicant would first like to state that in order to properly combine references there must be some teaching suggestion or motivation to combine the references. The CAFC in In re Lee, 16 USPQ2d, 1430, at page 1433 has stated:

> "When patentability turns on the question of obviousness, the
> search for and analysis of the prior art includes evidence relevant
> to the finding of whether there is a teaching, motivation, or

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suggestion to select and combine the references relied on as evidence of obviousness."... "The factual inquiry whether to combine references must be thorough and searching"...It must be based on the objective evidence of record."... ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references."... "(there must me some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant)."

In this regard the distributed service creation and distribution system of Nguyen is totally apart and distinct from the Shiota reference. The Shiota reference is directed to a network photographic service of affiliated laboratories with an central center server for fulfilling an order that a customer placed over the network. The Shiota reference is directed to a closed affiliated type of system. This is in contrast to the distributed service creation and distributions of Nguyen when there is provided a directory service utility that maintains a registry of service providers. As set forth at paragraph 35, there is provided a directory service utility that is aware of other service communities. There is provided a hierarchical relationship among service clusters 108A that communicate between directory service utilities 316. As set forth in paragraph 39, the cluster 108 of service communities 212 may be built in a scalable way. Each service community 212 in the cluster 108 comprises a set of local service providers 314 and a directory service utility 316 to periodically publish information about those service providers 314 within the service communities 212 using a proposed service information propagation method.

Paragraphs 46 and 47 briefly describe how the Nguyen system works. In particular, an inquiry is sent to the local directory service utility 316 requesting a particular service. If the requested service is available locally, a response is sent advising the address of a local service provider to the requestor. If not, available locally, the local service directory 316 sends a propagated inquiry to a remote directory service utility and this is propagated until a suitable provider is found.

As set forth in paragraph 71 of Nguyen, when more than one service provider is found, one service provider is selected and the address of the selected service provider is sent to the source of the query (step 1006), see Fig. 10. Thus, it is clear that the Nguyen reference is not directed to providing a list of service providers but locating a particular service provider and sending that information
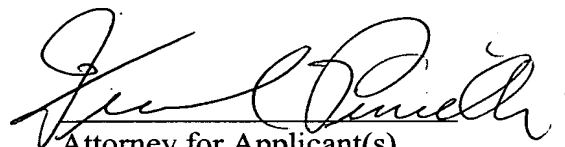
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to the individual that made the query. The Nguyen reference is directed to a hierarchical searching system for locating a service provider where as the Shiota reference is directed to a close type system, there is no teaching, suggestion or motivation to combine the references as taught and claimed by applicant. Further, the Nguyen reference fails to teach or suggest the providing of a list of service providers in response to the criterion provided by the user as claimed by applicants. In fact, Nguyen teaches away from such as in the case of where one or more service provider is located, only a single individual provider is sent to the requestor.

In view of the foregoing it is respectfully submitted that the prior art fails to teach or suggest the invention as set forth in independent claim 1. Accordingly, applicant respectfully submits that claim 1 and its dependent claims are patentably distinct over the cited references.

With regard to claims 20 and 21, theses are independent claims that are directed to a system and software product which includes similar limitations set forth in independent claim 1 as previously discussed and are therefore are patentably distinct for the same reasons previously discussed.

In view of the foregoing applicant respectfully submits that the claims in the present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.